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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,764	08/10/2000	Dah-Ben Liang	36912/CM/S61	7809

23363 7590 01/17/2003

CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

EXAMINER

SCHOEPPPEL, ROGER J

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,764

Applicant(s)

LIANG ET AL.

Examiner

Roger J. Schoeppel

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-37 and 39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 7-27, 36 and 39 is/are allowed.
- 6) ☒ Claim(s) 28-35 & 37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Art Unit: 3672

DETAILED ACTION

1. The revised Declarations and Assignee Consent are acceptable.
2. The numbering of claims is not in accordance with 37 CFR 1.173(e) which requires the original numbering of the claims to be preserved throughout the prosecution. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Since the original claim 38 was canceled in Paper No. 6 dated January 10, 2002, the new (misnumbered) claim 38 has been renumbered 39.
3. Claims 1-4, 7-37 and 39 remain in the application. Claims 5, 6 and 38 have been canceled.
4. Claims 1-4, 7-27, 36 and 39 are allowed.
5. Claims 28-35 and 37 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. Contrary to applicants arguments, the added material which is not supported by the prior patent is as follows:

Claims 28-35 and 37 all call for a particle size that is "less than " and/or "greater than" a certain mesh size which terminology is not included in the parent patent. The inclusion of either of these features make these claims indefinite as these limits may encompass values beyond those disclosed and therefor constitute new matter. More specifically and based on applicants own lexicon as per column 5, lines 39-42 of the patent for which reissue is requested, "(T)herefore, the range of sizes of the carbide particles in a filler is defined by the **largest** and **smallest** grade of mesh used to screen the particles" (emphasis added). The original claims 1-27 all specifically specify a mesh range in either the independent or dependent claims or both in application of this definition which claims were all approved in the parent application. Now however, applicants are claiming particles **less than** or **greater than** a certain mesh size which new lexicon defines particle sizes which are not disclosed in the specification. To be even more specific, the called for particles having a particle size for example of "less than 40 mesh" as called for in claim 28 will

Art Unit: 3672

consist of all particle sizes which will not be retained on a 40 mesh screen which particles could include dust!

6. Claims 28-35 and 37 are accordingly also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

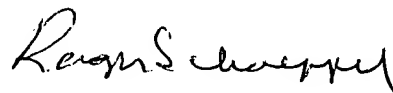
A shortened statutory period for reply to this final action is set to expire TWO MONTHS from the mailing date of this action. Any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Roger Schoepel whose telephone number is (703) 308-2147. The examiner can normally be reached on Monday through Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell, can be reached on (703) 308-2151. The fax phone number for this Art Unit is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

R. Schoepel/rjs
January 16, 2003



**ROGER SCHOEPEL
PRIMARY EXAMINER
ART UNIT 3672**